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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/907,265	07/17/2001	Richard O'Connell	21866-013	5604

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EXAMINER
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LIVERSEDGE, JENNIFER L

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/907,265	O'CONNELL, RICHARD	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jennifer Liversedge	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2001.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/25/2001 and 8/01/2002</u>                                              | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities: item 301 on Figure 4b is not found in the specification.

Appropriate correction is required.

Applicant is advised to review the specification for other similar missing items.

### ***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because several drawings and/or parts of drawings are freehand drawings. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Item 10 on page 8, line 26. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37

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CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Applicant is advised to review the drawings for other similar missing items.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 7-10, 14-17, 18-21 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/14711 to Andrasev (further referred to as Andrasev).

Regarding claim 1, Andrasev discloses a method for providing security to payment card transactions (page 5, line 30 – page 6, line 21) comprising:

Receiving information designating an account of a payment cardholder (page 10, lines 24-31);

In response to receiving account information, forwarding a request over a communications system to a mobile telephone of the payment cardholder for information identifying one or more authorized users of a payment card (page 11, lines 21-28);

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Receiving information identifying one or more payment card users from the mobile telephone of the payment cardholder (page 2, lines 29-33; page 12, line 33 – page 13, line 16);

In response to receiving payment card user identifying information, creating a validation record associated with the payment cardholder account and one or more authorized payment card users (page 2, lines 18-28; page 7, lines 14-22); and

Setting the validation record to authorize payment card transactions with use of a payment card by an authorized payment card user (page 6, line 21 - page 7, line 22).

Regarding claim 15, Andrasev discloses a method for authorizing payment card transactions (page 5, line 30 – page 6, line 21) comprising:

Receiving information designating an account of a payment card transaction (page 10, lines 24-31);

In response to receiving account information, forwarding a request over a communications system to a mobile telephone of the payment cardholder for information identifying one or more payment card users (page 11, lines 21-28);

Receiving information identifying one or more payment card users from the mobile telephone of the payment cardholder (page 2, lines 29-33; page 12, line 33 – page 13, line 16);

In response to receiving identifying information, retrieving a validation record associated with the cardholder account and one or more authorized payment card users (page 2, lines 18-28; page 7, lines 14-22); and

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Determining whether a status of a payment card user is one of authorized and unauthorized by reconciling information received identifying one or more payment card users with the validation record (page 6, line 21 - page 7, line 22); and

Completing the payment card transaction according to an authorization status of the payment card user (page 7, lines 14-22; page 10, line 24 - page 12, line 9).

Regarding claims 2 and 16, Andrasev discloses the method wherein the communications system includes a short messaging service using a short messaging transport protocol for forwarding a request to a mobile telephone of a payment cardholder as a text message (page 6, lines 21-33; page 11, lines 21-33).

Regarding claims 3 and 18, Andrasev discloses the method wherein receiving information identifying one or more payment card users includes receiving a verbal password associated with one or more authorized payment card users (page 1, lines 10-16).

Regarding claims 4 and 19, Andrasev discloses the method wherein receiving information identifying one or more payment card users includes receiving a verbal password and a personal identification code associated with one or more authorized payment card users (page 1, lines 10-16; page 2, lines 29-33).

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Regarding claim 5, Andrasev discloses the method wherein receiving information identifying one or more payment card users includes receiving a verbal password, a personal identification code and a mobile telephone number associated with one or more authorized payment card users (page 1, lines 10-16; page 2, lines 29-33; page 6, lines 26-33).

Regarding claim 6 and 17, Andrasev discloses the method wherein receiving information designating an account of a payment cardholder includes receiving information from an access device selected from the group consisting of a land-based telephone, a personal computer (page 20, lines 16-21), a personal digital assistance, an automated teller machine (ATM) (page 2, lines 5-17) and an Internet access device (page 2, lines 5-17; page 11, lines 13-21).

Regarding claim 7, Andrasev discloses the method wherein creating a validation record includes recording a verbal password associated with one or more authorized payment card users (page 1, lines 10-21; page 2, lines 18-28; page 7, lines 14-22).

Regarding claim 8, Andrasev discloses the method wherein setting the validation record includes verifying a verbal password provided by a payment card user is similar to a verbal password recorded in the validation record and associated with one or more authorized payment card users (page 1, lines 10-21; page 2, lines 18-28; page 7, lines 14-22).

Regarding claim 9, Andrasev discloses the method wherein creating the validation record further includes creating a validation record database (page 2, lines 18-28; page 7, lines 14-22).

Regarding claims 10 and 21, Andrasev discloses the method wherein the method further comprising providing access by a payment cardholder to the database, receiving information from the payment cardholder, and storing the information in the database (page 2, lines 21-33; page 6, lines 27-33; page 7, lines 14-22).

Regarding claims 14 and 25, Andrasev discloses the method wherein receiving information from a payment cardholder includes receiving information from a mobile telephone (page 6, lines 27-33; page 11, lines 21-33).

Regarding claim 20, Andrasev discloses the method wherein retrieving a validation record includes retrieving a validation record from a database (page 2, lines 18-28; page 7, lines 14-22).

Regarding claim 26, Andrasev discloses the method wherein completing payment card transactions according to an authorization status of the payment card user includes notifying the payment cardholder of the status of the payment card user (page 14, lines 18-20).



Regarding claim 27, Andrasev discloses the method wherein notifying the payment cardholder of the status of the payment card user includes forwarding a text message to a mobile telephone of the payment cardholder by a short message service using a short messaging transport protocol (page 6, lines 21-33; page 11, lines 21-33).

Claims 28 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 745 961 A2 to AT&T IPM Corp by Blonder et. al (further referred to as Blonder).

Regarding claim 28, Blonder discloses a system for providing information to identify a payment card authorization system (column 3, lines 22-31) comprising:

A central manager including a database to record and store information identifying a plurality of payment cardholders and payment card users of the authorization system (column 5, line 31 – column 6, line 40);

The central manager coupled to a Short Message Service module to forward text messages to payment cardholders via mobile telephone (column 8, lines 20-28; column 19, lines 51-58; Figure 10); and

The central manager further coupled to a Voice Recognition module and an Interactive Voice Recognition module for voice communication between the central manager and payment cardholders and payment card users via mobile telephone (column 10, lines 29-37; column 19, lines 51-58; Figure 1).

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Regarding claim 30, Blonder discloses the system wherein the central manager is further coupled to one or more credit authorization systems (column 5, line 28 – column 6, line 40).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 11-13 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andrasev as applied to claim 10 above, and further in view of EP 0 745 961 A2 to AT&T IPM Corp by Blonder et. al (further referred to as Blonder).

Regarding claims 11 and 22, Andrasev does not disclose the method wherein receiving information from a payment cardholder and storing the information in the

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database includes receiving and storing information in the database for pre-authorizing one or more payment card transactions of one or more authorized payment card users for a predetermined period of time. However, Blonder discloses the method wherein receiving information from a payment cardholder and storing the information in the database includes receiving and storing information in the database for pre-authorizing one or more payment card transactions of one or more authorized payment card users for a predetermined period of time (column 7, lines 16-23 and lines 42-47; column 8, lines 31-35). It would be obvious to one of ordinary skill in the art to combine the use of preauthorized limits for predetermined periods of time as disclosed by Blonder with the mobile authorization system as disclosed by Andrasev. The motivation would be to create situations where purchases can be pre-approved for a defined time period to ensure that transactions outside of those limits are rejected, thus increasing security offered to the account.

Regarding claims 12 and 23, Andrasev does not disclose the method wherein receiving information from a payment cardholder and storing the information in the database includes receiving and storing information in the database for blocking one or more payment card transactions of one or more payment card users of one or more authorized payment card users for a predetermined period of time. However, Blonder discloses the method wherein receiving information from a payment cardholder and storing the information in the database includes receiving and storing information in the database for blocking one or more payment card transactions of one or more payment

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card users of one or more authorized payment card users for a predetermined period of time (column 7, lines 16-23 and lines 32-47; column 8, lines 29-38; column 9, lines 24-36). It would be obvious to one of ordinary skill in the art to combine the use of blocking transactions for predetermined periods of time as disclosed by Blonder with the mobile authorization system as disclosed by Andrasev. The motivation would be to create situations where purchases can be blocked for a defined time period to ensure that transactions which are undesired and perhaps suspected are rejected, thus increasing security offered to the account.

Regarding claims 13 and 24, Andrasev does not disclose the method wherein receiving information from a payment cardholder and storing the information in the database includes receiving and storing information in the database for pre-authorizing one or more payment card transactions of one or more authorized payment card users within a predetermined transaction value limit. However, Blonder discloses the method wherein receiving information from a payment cardholder and storing the information in the database includes receiving and storing information in the database for pre-authorizing one or more payment card transactions of one or more authorized payment card users within a predetermined transaction value limit (column 7, lines 16-23 and lines 42-47; column 8, lines 31-35). It would be obvious to one of ordinary skill in the art to combine the use of preauthorized limits for predetermined transaction value limits as disclosed by Blonder with the mobile authorization system as disclosed by Andrasev. The motivation would be to create situations where purchases can be pre-approved for

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a defined value limit to ensure that transactions outside of those limits are rejected, thus increasing security offered to the account and preventing overspending above an approved limit.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blonder. Blonder does not specifically disclose the system wherein the central manager operates as a software module operating on one or more computers. However, Blonder discloses a computer system which includes a communication network, a validation database, and a paging system network (column 5, lines 28-48), in which databases and processors are used to operate the system of authorizing transactions (column 6, lines 24-40). It would be obvious to one of ordinary skill in the art that software would be used as part of the computer system as disclosed by Blonder, as software is the mechanism by which computer systems operate.

### ***Conclusion***

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached at 571-272-6799. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

Art Unit 3628

  
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SUPERVISORY PATENT EXAMINER  
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